

Application No. 09/743,649

RCA 88,650

**REMARKS**

Claims 1 - 11 are pending in this application.

Applicant wishes to thank the Examiner for the courtesy extended in a telephone interview discussing the appropriateness of the finality of the outstanding Office Action as indicated on the summary page of the Office Action. In this interview the Examiner indicated that in view of the filing of an RCE on September 19, 2005, this Office Action should not be a Final Office Action and should be responded to as a non-Final Office Action.

**Rejection of Claims 1-11 under 35 USC § 103(a)**

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers et al. (U.S. Patent No. 5,063,547) in view of Best (U.S. Patent No. 4,569,026) in further view of Ito et al. (U.S. Patent No. 5,499,221). Applicants respectfully traverse the rejections.

The present claimed invention provides a method and apparatus for controlling a system for processing stored information on a storage medium. Stored information is played back during a play mode of operation and the user is provided an opportunity to select a bookmark representing a corresponding location at any point within the stored information from among a plurality of bookmarks responsive to the user's input during play mode. The stored information is played back from the location corresponding to the selected bookmark during the play mode of operation. An on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium is generated. The user is allowed to perform one of setting a new bookmark; selecting a bookmark and clear the selected bookmark; selecting the bookmark and play back the stored information from the location corresponding to the selected bookmark; and undoing a previously performed operation while continuing to watch program information playback in a background portion of the video display. In response to a

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user selecting a bookmark, the playback circuitry retrieves information from the storage medium starting at the location corresponding to the selected one of a plurality of bookmarks during the play mode of operation. This eliminates the need to press fast-forward to scroll to the user's desired point in the video. Independent claims 1 and 11 contain features similar to those discussed above and thus all arguments presented below apply to both claims.

Custers et al. describe a Compact-Disc Digital Audio player in which different users, independently of one another, can store preferred selections of specific discs in a memory. The player identifies the discs from the sub-code on the disc. The user identification can be entered in the player. The user identification and the record carrier identification are combined to form one identification code. The player also detects whether a preferred selection program is stored in the memory associated with the identification code. If an identification code is stored, the player reproduces the relevant information from the disc in the sequence specified by the preferred-selection program.

The Examiner contends that Custers et al. disclose a method and apparatus of controlling a system for processing stored information on a storage medium similarly to the present invention. Applicants respectfully disagree. Although Custers et al. describe a Compact-Disc Digital Audio player that can store a preferred selection of specific discs in a memory, Custers et al. neither disclose nor suggest bookmarks "representing a corresponding location at any point within the stored information" as recited in the present claimed invention. Conventional media disc menus are configured such that the user can begin playback from the starting point of a selected video title or chapter. The menus, however, do not allow the user to select an arbitrary point within a video title or chapter for starting playback. However, the present claimed invention allows the user to set bookmarks "representing a corresponding location at any point within the stored information" as recited in the present claimed invention. By providing for bookmarks to be set at any point within the stored information, the present claimed invention provides users with the convenience of jumping to a pre-selected location within a video title or

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chapter without having to manipulate the various transport keys in order to locate and start the playback.

In column 3, lines 7-10, Custers et al. states that "The player has the possibility of storing preferred program selections of a plurality of discs in a memory, identifying, discs to be played and, if desired, playing the preferred program selection." While the "preferred program selection" in Custers et al. may represent bookmarks of specific tracks on discs, these "preferred program selection" in Custers et al., however, neither disclose nor suggest bookmarks "representing a corresponding location at any point within the stored information", as recited in the present claimed invention

Additionally, Custers et al. neither disclose nor suggest "providing to a user, during play mode of operation, an opportunity to select a bookmark" or "set[ting] a new bookmark...while continuing to watch program information playback in a background portion of the video display" as recited in independent claims 1 and 11 of the present invention. Contrary to the contention in the Office Action, column 6, lines 20-29, of Custers et al. describe starting the program by putting on a disc, and subsequently, a number of parameters are initialized in block 15, such as the parameters which indicated the address in the preferred-selection memory 6 and F which is a flag used in the program. Nowhere is it disclosed or suggested in Custers et al. that the user has the ability to mark various selections while the disc is playing. In fact, in column 6, lines 29-34, Custers et al. states that "If the user does not wish to use the preferred-selection facility, the program proceeds directly to block 26 to play the disc in the customary manner, as the case may be with a single selection via the keyboard 1, which program choice is stored in the program memory", thus showing that as the program is started by putting in a disc, a number of parameters are initialized, but the disc does not actually play until the user chooses to play the disc.

The Office Action further asserts that column 3, lines 7-15, of Custers et al. describes the disc being played back for the user to mark segments throughout the disc. Applicants respectfully disagree. While Custers et al. provides for storing preferred program selections of a plurality of discs in a memory to be played later on, Custers et

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al. still neither disclose nor suggest “providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information” as recited in the present claimed invention. Custers et al. is only concerned with providing different users, independent of one another, the ability to store preferred selections of specific discs in a memory. Custers et al., as described, teach a system that organizes preferred selections of programs to be played in sequence. These preferred selections represent tracks or chapters on a disc. These preferred selections, however, do not represent a corresponding location at any point within the stored information as in the present claimed invention.

Best describes a video entertainment system by which human viewers conduct simulated voice conversation with screen actors or cartoon characters in a branching story game shown on a television screen. Different audio and video frames are generated from a videodisc and data memory to provide one of several alternative replies or alternative actions at each branch point in the game, depending on what the viewer says to a speech-recognition unit. Best, similar to Custers et al., neither discloses or suggests “providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information; from among a plurality of bookmarks responsive to user input” as recited in the present claimed invention. Best allows the user to interact with the video entertainment system via voice commands. In Best, points in the game are represented by special story commands which can point to several subsequent chains of story commands. These chains of commands, however, do not allow the user to “set a new bookmark”, nor does it allow the user the ability to “select a bookmark and clearing the selected book mark” as recited in independent claims 1 and 11 of the present invention. The prompted commands are predetermined by the game system, not the user.

Ito et al. describe a portable CD-ROM retrieval apparatus. A CD-ROM drive loads a CD medium. A color liquid crystal display shows characters and images and similar information output of the CD-ROM drive and showing a menu. A joypad directing device selects a desired menu item. An audio output circuit outputs audio

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information such as music or voice. These components are integrated in a single unit.  
The Office Action asserts that Ito et al. discloses a CD-ROM retrieval apparatus which retrieves position wherein the user has left a bookmark at any position on the recording medium. Applicant respectfully disagrees. While Ito et al. can store position information such as last read page and line, and "automatically retrieves the position which is to start reading" (Ito et al., col. 12, lines 29-31), the apparatus does not actually store bookmarks in response to user input. Thus Ito et al., similarly to Custer et al. and Best, neither disclose or suggest "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" as recited in the present claimed invention.

Additionally, there is no motivation or reason to combine Custers et al., Best, and Ito et al. to provide an apparatus that reads information in a sequence. Best, contrary to Custers et al. and Ito et al., provides an interactive video entertainment system that responds to voice commands to play the appropriate programs in response to the commands. Best combines an apparatus for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands. Custers et al. provides for users to make selections to be stored in memory prior to playback while the Best system requires that the user, in an interactive video entertainment environment, make a selection while a media disc is being played. Ito et al. provides a CD-ROM retrieval apparatus. Ito et al. does not provide storage of user preferences. Thus, the combination of the systems of Custers et al., Best and Ito et al. would provide for a CD-ROM retrieval system that requires a user to predetermine a sequence for playback while also requiring a user to make a selection during playback of a media disc. Consequently, it is respectfully submitted that the operation of the systems of Custers et al., Best and Ito et al. are conflicting and thus there is no motivation or reason to combine Custers et al. and Best.

However, even if one were to combine the three systems, the combination would produce a CD-ROM retrieval digital audio player for automatically reproducing user-defined preferred selections with a video game entertainment system that responds

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to voice commands and that can store preferred selections of specific discs in a memory. This combination would still not allow a user to retrieve a bookmark representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input. Therefore, similar to the individual systems, the combination of the systems of Custers et al., Best and Ito et al. neither disclose nor suggest retrieving bookmarks "representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" as recited in the present claimed invention

In view of the above remarks and amendments to the claims it is respectfully submitted that Custers et al. Best, and Ito et al., when taken alone or in combination, provide no 35 USC § 112 compliant enabling disclosure showing the above discussed features. Thus, it is respectfully submitted that Custers et al., Best, and Ito et al., when taken alone or in combination, do not make the present invention as claimed in Claims 1 and 11 unpatentable.

As Claims 2-10 are dependent on Claim 1, it is respectfully submitted that these claims are also allowable for the same reasons discussed above. It is thus respectfully submitted that these rejections are satisfied and should be withdrawn.

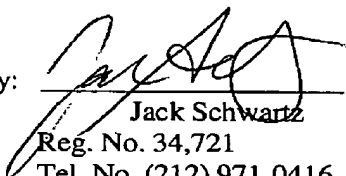
Having fully addressed the Examiner's rejections, it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at the phone number below, so that a mutually convenient date and time for a telephonic interview may be scheduled.

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No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account 50-2828.

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